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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,319	10/31/2003	John Deryk Waters	300203672-2	8521

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EXAMINER

DHINGRA, PAWANDEEP

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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09/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/697,319

Applicant(s)

WATERS, JOHN DERYK

Examiner

Pawandeep S. Dhingra

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/31/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- This action is responsive to the following communication: a Response to Restriction Requirement filed on 08/13/2007.
- Claims 1-4, and 6-13 are elected in the present application; claims 5 have been non-elected by the applicant in response to the election made with traverse by the applicant.
- The examiner has examined all the claims.

Response to arguments

Applicant's arguments, see page 1, filed 8/13/2007, with respect to Response to Election/Restriction have been fully considered and are persuasive. The examiner respectfully withdraws the Requirement for Election/Restriction filed on 7/13/2007.

Double Patenting

1. Claims 1-13 are rejected on the ground of nonstatutory double patenting over claims 1-14 of U. S. Patent No. 7,077,489 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Application 10/697,319	US Patent No. 7,077,489
Apparatus for printing and data writing to a memory tag	Apparatus for printing and memory tag application

Print head for printing	Print head for printing
Memory tag write device for data writing to tags	Memory tag dispenser for applying memory tags and to enable application of memory tags to the base medium at desired locations
Part of Memory tag write device is moveable relative to the base medium along a second axis perpendicular to first axis	Memory tag dispenser is moveable relative to the base medium in a direction which is perpendicular to a direction in which the base medium moves

The above analysis of claim 1 is exemplary of all the pending claims. The rest of the claims recite the same limitations or broader versions as claimed in the U. S. Patent No. 7,077,489.

Note the comparison above, claims 1-13 of the instant application is not patentability distinct from claim 1-14 of the U. S. Patent No. 7,077,489 because claims 1-13 of the instant application are rendered obvious over claims 1-14 of U. S. Patent No. 7,077,489. For example, claim 1 of the instant application includes the limitation – memory tag writing device for data writing to tags. However, it would have been obvious to have a memory tag writing/reading device as a separate unit for writing data to memory tags for the benefit of achieving faster and error-free processing in the apparatus of U. S. Patent No. 7,077,489. Hence, the claims cover common subject matter and all the limitations in the pending claims are anticipated by the U. S. Patent No. 7,077,489 claims.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Examiner Notes

Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 6-8, and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Austin et al., US 6,645,327.

Re claim 1, Austin discloses an apparatus for data printing (see fig. 2) and data writing to a memory tag on or in a base medium (see fig. 2; column 5, line 47-column 7, line 39), the apparatus having a print head (see element 12, fig. 2) for printing onto the base medium (see element 100, fig. 2), and a memory tag write device (see element 44, fig. 2) for data writing to the memory tag (i.e. RF tags) on or in the base medium (see fig. 2; column 5, line 47-column 7, line 50), wherein the base medium is moved along a first axis (right to left axis, see fig. 2) through or past the apparatus (see fig. 2; column 5, line 47-column 7, line 50), and at least a part of the memory tag write device (i.e. supply roller 34, figure 2) required for communication with the memory tag is moveable relative to the base medium (see element 110, fig. 2) back and forth along a second axis (i.e. into and out of the page when looking at figure 2) substantially perpendicular to the first axis (see column 5, line 47-column 7, line 50, note that the roller 34 moves along the axis (clockwise or counterclockwise) pointing into and out of the page (the z axis) when looking at figure 2. The roller 34 moves on an axis into and out of the page (the z-axis), which is perpendicular to the right to left axis (the x-axis) that the base medium moves along).

Re claim 2, Austin further discloses the print head (element 12, fig. 2) is moveable relative to the base medium and moves back and forth along a third axis (into and out of the page, when looking at figure 2) substantially perpendicular to the first axis (see figure 2; column 5, line 47-column 7, line 50, note that the print head 12 moves on an axis into and out of the page (the z-axis), which is perpendicular to the right to left axis (the x-axis) that the base medium moves along. The first axis can be considered as

the x-axis while the third axis can be the z-axis, these axes are perpendicular, by definition).

Re claim 6, Austin further discloses the memory tag write device (element 240, fig. 12) is a memory tag read/write device (see column 10, line 54-column 12, line 65), such that the data written to the memory tags can be read and checked after being written (see column 10, line 54-column 12, line 65).

Re claim 7, Austin further discloses the memory tag write device (element 240, fig. 12) is a memory tag read/write device (see column 10, line 54-column 12, line 65), such that data written to memory tags on previously printed base medium can be read from those memory tags when the previously printed base medium is moved through or past the apparatus (see figures 8-9, 12; column 7, lines 25-30; column 10, line 54-column 12, line 65).

Re claim 8, Austin further discloses the data once read is used to print additional copies of the previously printed base medium (column 10, line 54-column 12, line 17).

Re claim 11, claim 11 recites similar features as claims 1 & 2 above and is rejected on the same grounds.

Re claim 12, Austin discloses a method of printing onto a base medium (see figure 2) and writing to a memory tag (see 112, fig. 2) on or in the base medium (see column 5, line 47-column 7, line 50) comprising the steps of: i) feeding the base medium along a first axis (right to left axis, fig. 2) past a print head (see 12, fig. 2); ii) printing onto the base medium (see column 5, line 47-column 7, line 50); iii) feeding the base

medium past a memory tag write device (see 44, fig. 2) (see column 5, line 47-column 7, line 50); iv) moving the memory tag write device (see 44, fig. 2) along a second axis (i.e. into and out of the page, when looking at figure 2) substantially perpendicular to the first axis (right to left axis, fig. 2) to the location of a memory tag in or on the base medium (see figure 2; column 5, line 47-column 7, line 50, note that the write head 44 moves on an axis into and out of the page (the z-axis), which is perpendicular to the right to left axis (the x-axis) that the base medium moves along. The first axis can be considered as the x-axis while the third axis can be the z-axis, these axes are perpendicular, by definition), and v) writing data to the memory tag in or on the base medium (see column 5, line 47-column 7, line 50).

Re claim 13. Austin further discloses it further includes the step of moving the print head (12, fig. 2) relative to the base medium see column 5, line 47-column 7, line 50) along a third axis (i.e. into and out of the page axis of figure 2) substantially perpendicular to the first axis (right to left axis, fig. 2) in order to print onto the base medium in required locations (see column 5, line 47-column 7, line 50).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5, and 9-10 are rejected under 35 U.S.C. 103 as being unpatentable over Austin et al., US 6,645,327 in view of Hohberger et al. US 6,857,714.

Re claim 3, Austin further discloses the print head and the part of the memory tag write device are connected together (see figures 1-2; column 5, line 47-column 7, line 39, note that elements 12 and 44 (or 34) are connected together and are part of the same housing). Austin further discloses that print head 12 moves relative to the base medium along a third axis (into and out the page, when looking at fig. 2) (see figure 2; column 5, line 47-column 7, line 50).

Austin fails to explicitly disclose that print head and part of the memory tag write device moves in unison along the second axis and third axis.

However, Hohberger teaches that print head (see print head 18, fig. 21) and part of the memory tag write device (see elements 320, 330, fig. 21, note that these supply mechanisms are part of the memory write device (i.e. print head)) moves in unison along the second axis (up and down in figs 21 and 22) and third axis (into and out of the page axis of figure 21) (see column 18, line 63-column 19, line 50).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention to modify the RF tag application system as disclosed by Austin to include the apparatus for applying RFID labels as taught by Hohberger for the benefit of *"selectively incorporating a value-adding element such as, for example, a radio frequency identification (hereinafter called RFID) transponder with individual media*

samples on a programmed, on-demand basis" as taught by Hohberger at column 1, lines 14-26.

Re claim 4, Austin further discloses the print head (12, fig. 2) and the part of the memory tag write device (44 or 34, fig. 2) are amalgamated into a single unit (see figures 1-2; column 5, line 47-column 7, line 39, note that elements 12 and 44 (or 34) are part of the same housing).

Austin fails to explicitly disclose that the second and third axes coincide.

However, Hohberger teaches that the second and third axes coincide (i.e. happen together) (see figure 21-22, and discussion of claim 3 above).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention to modify the RF tag application system as disclosed by Austin to include the apparatus for applying RFID labels as taught by Hohberger for the benefit of *"selectively incorporating a value-adding element such as, for example, a radio frequency identification (hereinafter called RFID) transponder with individual media samples on a programmed, on-demand basis"* as taught by Hohberger at column 1, lines 14-26.

Re claim 5, Austin fails to explicitly disclose that the print head and the part of the memory tag write device move independently along the second and third axes.

However, Hohberger teaches that the print head (18, fig. 21) and the part of the memory tag write device (320, 330, fig. 21, note that supply mechanism are part of the

memory tag write device) move independently along the second (up and down in figs 21 and 22) and third axis (into and out of the page axis of figure 21) (see fig 21-23).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention to modify the RF tag application system as disclosed by Austin to include the apparatus for applying RFID labels as taught by Hohberger for the benefit of *"selectively incorporating a value-adding element such as, for example, a radio frequency identification (hereinafter called RFID) transponder with individual media samples on a programmed, on-demand basis"* as taught by Hohberger at column 1, lines 14-26.

Re claim 9, Austin failed to further disclose it is adapted to handle base medium in loose sheet form, which passes through the apparatus.

However, Hohberger discloses it is adapted to handle base medium in loose sheet form (i.e. discrete media), which passes through the apparatus (see column 11, lines 24-43).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention to modify the RF tag application system as disclosed by Austin to include the apparatus for applying RFID labels as taught by Hohberger for the benefit of *"selectively incorporating a value-adding element such as, for example, a radio frequency identification (hereinafter called RFID) transponder with individual media samples on a programmed, on-demand basis"* as taught by Hohberger at column 1, lines 14-26.

Re claim 10, Austin further discloses, "Label media and the material used to produce it typically include label stock, made from paper or plastic (see column 1, lines 46-48).

Austin failed to further disclose it is adapted to handle loose sheets of paper or like material.

However, Hohberger discloses it is adapted to handle loose sheets (i.e. discrete media) of paper or like material (i.e. plastic) (see column 11, lines 24-43).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention to modify the RF tag application system as disclosed by Austin to include the apparatus for applying RFID labels as taught by Hohberger for the benefit of "selectively incorporating a value-adding element such as, for example, a radio frequency identification (hereinafter called RFID) transponder with individual media samples on a programmed, on-demand basis" as taught by Hohberger at column 1, lines 14-26.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pawandeep S. Dhingra whose telephone number is 571-270-1231. The examiner can normally be reached on M-F, 9:30-7:00.

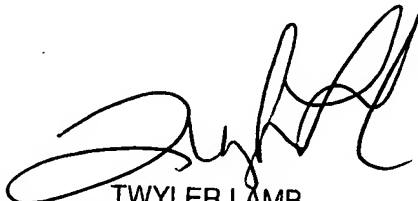
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on 571-272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Pd
August 23, 2007



TWYLER LAMB
SUPERVISORY PATENT EXAMINER